

REMARKS

Applicants respectfully request reconsideration of this application in view of the present amendments and following remarks. By this amendment, claims 51 and 52 are cancelled. Claims 48, 49, 53, 54, 60-65, 67-70, 78, 79, 84, 86, 99, 105, and 116 have been amended. Accordingly, claims 48-50 and 53-126 remain pending in the application, with claims 48, 84, and 116 being independent claims. No new claims have been added. Therefore, it is believed that no fees are required in addition to the requisite fees for the three-month extension of time and for the Request for Continued Examination (RCE). However, if additional fees are due, the Commissioner is authorized to charge such fees to Deposit Account Number 13-2855.

Claim 49 stands objected due to a missing limitation in the phrase “at one reel display.” Claim 49 has been amended to recite that the display device comprises “at least one reel display.” Applicants respectfully submit that claim 49 is now complete, and respectfully request withdrawal of the Examiner’s objection.

Claims 65, 66, and 99 were rejected under 35 U.S.C. §112 for omitting essential elements. Claims 65 and 99 have been amended to include a gaming award being dispensed upon the occurrence of a winning secondary outcome. Claim 66 depends from claim 65 and, therefore, is submitted to be complete. Applicants respectfully submit that claims 65, 66, and 99 contain all the essential elements, and reconsideration and withdrawal of the Examiner’s rejection with respect to claims 65, 66, and 99 is respectfully requested.

Claims 48-126 stand rejected under 35 U.S.C. §102(e) as being anticipated by Kelly et al. (U.S. Patent No. 5,816,918). Claims 53-55 and 86-88 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. in view of Seibert, Jr. et al. (U.S. Patent No. 5,785,594). Claims 56 and 89 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. in view of Fey (Slot Machines, p. 162). Claims 57, 58, 90 and 91 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. in view of Harlick (U.S. Patent No. 5,941,773). Claims 64 and 98 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. in view of Harrison (U.S. Patent No. 5,934,671). Claims 65, 66, and 99 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. in view of Baerlocher et al. (U.S. Patent No. 5,788,573).

Claims 67-77 and 100-110 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. in view of Mullins (U.S. Patent No. 5,158,293). Claims 123-126 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. in view of Boushy (U.S. Patent No. 5,761,647). Reconsideration is respectfully requested.

Amended claim 48 recites, *inter alia*, a first output device dispensing a gaming award and a second output device adapted to dispense a ticket that is not a gaming award after the occurrence of a triggering event, wherein the triggering event is not an occurrence of a winning outcome of the wagering game or a cumulative result of a plurality of outcomes of the wagering game, and wherein the triggering event is not every occurrence of the wagering game. Kelly et al. does not teach these limitations and, therefore, does not anticipate or render obvious the present invention as recited in claim 48. First, Kelly et al. only discloses dispensing tickets that are gaming awards. Kelly et al. discloses a universal ticket dispenser and a specific ticket dispenser that can dispense tickets based on a player achieving a predetermined goal or task during the game. See Kelly et al., column 8, lines 25-32. Kelly et al. further teaches that each of the tickets dispensed by the dispensers 20 and 22 are equal to one prize credit accumulated by the player during the game. Kelly et al., column 8, line 49. In column 9, line 21, Kelly et al. states that the amount of the universal ticket dispensed to the player is typically based upon a game score or other result of a game process. In addition, special progressive goals may be achieved by the player to win addition or specified number of tickets. Continuing in column 9, line 46, a specific prize or instant prize can be dispensed from a specific prize ticket dispenser wherein a particular prize or type of prize that a player can directly and immediately be awarded, and in most cases immediately received due to a particular winning result on a game. Thus, Kelly et al. dispenses gaming awards in the form of tickets, and does not disclose or suggest dispensing tickets that are not gaming awards. For at least this reason, Kelly et al. does not anticipate or render obvious claims 48-50 and 53-83.

Additionally, because the universal and specific prize tickets are gaming awards, it follows that the triggering event for dispensing the prize tickets is the occurrence of a winning outcome or a cumulative result of a plurality of outcomes (e.g., predetermined goal or task). Moreover, the other cited references do not appear to teach or suggest the

limitations of claim 48 missing from Kelly et al. Consequently, for these reasons, Kelly et al and the other cited references do not anticipate or render obvious claims 48-50 and 53-83.

Regarding claims 80-82, claim 80 recites a gaming device with a printer that prints based on signals generated at a remote location from the gaming device. The Examiner cites to Fig. 2 of Kelly et al. as disclosing these limitations. Fig. 2 of Kelly et al. illustrates a game apparatus 10, 50 connected to another game apparatus 50 having a ticket dispenser 22. Kelly et al. does not, however, disclose or suggest that the ticket dispenser 22 at the game apparatus 50 operates in response to signals from the other game apparatus 10, 50, or from any other source remotely located from the game apparatus 50. Therefore, for at least this additional reason, claims 80-82 are neither anticipated nor rendered obvious by Kelly et al.

Amended claim 84 recites similar limitations to claim 48 wherein a ticket that is not a gaming award is dispensed after the occurrence of a triggering event, and “the triggering event is not an occurrence of a winning outcome or a cumulative result of a plurality of outcomes of the wagering game.” Therefore, for the reasons discussed above, Kelly et al. and the other cited references also do not anticipate or render obvious claims 84-115.

Regarding claims 112-114, similar to claim 80, claim 112 recites a method for printing tickets corresponding to a signal generated at a location remote from the gaming device. Therefore, for the additional reasons discussed above with respect to claims 80-82, claims 112-114 are also not anticipated or rendered obvious by Kelly et al. Reconsideration of the rejection is respectfully requested.

Claim 116 as amended includes, *inter alia*, accumulating comp points for the player as the player plays the wagering game, wherein the comp points are not determined by random chance or by skill of the player. Kelly et al. does not disclose accumulating comp points by any means other than a winning outcome based on a predetermined outcome of a game of chance, or a winning outcome based on the player’s skill as discussed above. The other references do not provide the teaching missing from Kelly et al. and, therefore, claims 116-126 are neither anticipated nor rendered obvious by the cited references. Applicants

It is respectfully submitted this Amendment traverses and overcomes all of the Examiner's objections and rejections to the application as originally filed. It is further submitted that this Amendment has antecedent basis in the application as originally filed, including the specification, claims, and drawings, and that this Amendment does not add any new subject matter to the application. Reconsideration of the application as amended is requested. It is respectfully submitted that this Amendment places the application in suitable condition for allowance; notice of which is requested.

If the Examiner feels that prosecution of this present application can be expedited by way of an Examiner's amendment or further communication, the Examiner is invited to contact the applicant's attorney at the telephone number listed below.

Dated: February 16, 2004

Respectfully submitted,

By Matthew D. Fair
Matthew D. Fair
Registration No.: 51,662
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant